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Attorney's Docket No.: 12587-015001 / D01-075

### REMARKS

Claims 1-40, 43, 44, and 50-55 are pending in this application, of which claims 1, 14, 27, 40, and 54 are independent. Favorable reconsideration is respectfully requested in view of the following remarks:

#### 35 U.S.C. § 101 rejections

Claim 50 is rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claim 50 depends on claim 1, which the applicant believes is clearly directed to statutory subject matter.

If the examiner is referring instead to independent claim 54, the applicant respectfully submits that claim 54 is also clearly directed to statutory subject matter. Claim 54 recites a computer-implemented method for distribution of digital content that includes "enabling secure distribution of the content according to the stored publication information." The step of enabling secure distribution of content is not merely a manipulation of an abstract idea. Rather, this step produces a concrete, tangible, and useful result. Withdrawal of the 101 rejection is requested.

#### 35 U.S.C. § 103 rejections

Claims 1-7, 10, 12-20, 23, 25-33, 38-41, 41, 43, 44, and 50 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Downs et al. (US Pat. 6,226,618). It also appears from page 13 and 14 of the Office Action that claims 54 and 55 are also being rejected under 35 U.S.C. § 103(a) as being unpatentable over Downs.

Claim 1 has been amended to recite "receiving publication information comprising distribution information that identifies one or more content distributors selected to distribute the digital content."

On page 3 of the Office Action, the examiner states that "when Downs et al.'s system receives the content portion of the content SC it is embedded with a watermark of publication information including distribution information that identifies one or more content distributors." (emphasis added)

The applicant respectfully disagrees. The embedded watermark "provides the means to identify the origin of authorized or unauthorized copies of Content." (Col. 7, lines 56-57) In

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particular, the embedded watermark identifies the content proprietor, specifies copyright information, and defines geographic distribution areas for the digital content. (Col. 7, lines 58-61) Nowhere does Down disclose or suggest use of the watermark in identifying content distributors selected to distribute the digital content. There is no need or motivation to include such distribution information because Downs notifies all authorized content distributors (or Electronic Digital Content Stores, as he calls them) in the system when new content is available. (col. 68, lines 35-40). The process of becoming an authorized content distributor is described in detail at col. 42, line 36 – col. 43, line 56 of Downs, which states in relevant part:

An Electronic Digital Content Store(s) 103 that wants to participate as a seller of Content 113 in the Secure Digital Content Electronic Distribution System 100 makes a request to one or more of the Digital Content Provider(s) 101 that provide Content 113 to the Secure Digital Content Electronic Distribution System 100. There is no definitive process for making the request so long as the two parties come to an agreement. After the [Digital Content Provider(s) 101] decides to allow the Electronic Digital Content Store(s) 103 to sell its Content 113, the Clearinghouse(s) 105 is contacted, usually via E-mail, with a request that the Electronic Digital Content Store(s) 103 be added to the Secure Digital Content Electronic Distribution System 100. The digital content label provides the name of the Electronic Digital Content Store(s) 103 and any other information that may be required for the Clearinghouse(s) 105 to create a digital certificate for the Electronic Digital Content Store(s) 103. The digital certificate is sent to the [Digital Content Provider(s) 101] in a secure fashion, and then forwarded by the [Digital Content Provider(s) 101] to the Electronic Digital Content Store(s) 103.

...  
After the Electronic Digital Content Store(s) 103 has received its digital certificate that was created by the Clearinghouse(s) 105 and the necessary tools for processing the SC(s) from the digital content label, it can begin offering Content 113 that can be purchased by End-User(s). The Electronic Digital Content Store(s) 103 includes its certificate in the Offer SC(s) 641 and the Transaction SC(s) 640 and signs the SC(s) using its Digital Signature 643. The End-User Device(s) 109 verifies that the Electronic Digital Content Store(s) 103 is a valid distributor of Content 113 on the Secure Digital Content Electronic Distribution System 100 by first checking [a] digital certificate revocation list [maintained by the Clearinghouse(s) 105] and then using the Public Key 621 of the Clearinghouse(s) 105 to verify the information in the digital certificate for the Electronic Digital Content Store(s) 103.

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Once authorized, a content distributor in Downs can distribute any item of digital content for the system. Nowhere does Downs disclose or suggest that the watermark provides for identification of a select subset of the authorized content distributors in the system to distribute a particular item of digital content. Accordingly, no component of the Downs system receives or otherwise includes "publication information comprising distribution information that identifies one or more content distributors selected to distribute the digital content."

For at least these reasons, the applicant respectfully submits that claim 1 and its dependents are in condition for allowance.

The foregoing remarks also apply to independent claims 14, 27, 40, and 54, which have corresponding limitations, and the claims that depend, directly and indirectly, from claims 14, 27, 40, and 54.

The dependent claims are allowable for at least the reasons stated above with respect to the independent claims from which they depend.

Claims 8, 21, and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Downs et al. in view of Saito et al. (EP 1041823A2). Claims 8, 21, and 34, which depend on independent claims 1, 14, and 27 respectively, are allowable for at least the reasons stated above.

Claims 9, 22, and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Downs in view of Brown et al. (US Pub. 2004/0064471). Claims 9, 22, and 35, which depend on independent claims 1, 14, and 27 respectively, are allowable for at least the reasons stated above.

Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Downs and Brown further in view of Gilliam et al. (US Pub. 2004/0039704). Claim 11, which depends on independent claim 1, is allowable for at least the reasons stated above.

Claims 24 and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Downs in view of Gilliam. Claims 24 and 37, which depend on independent claims 14 and 27 respectively, are allowable for at least the reasons stated above.

#### Conclusion

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or

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concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: \_\_\_\_\_

2/14/05



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